same as Examples 1 to 4 except that the nonionic non-fluorine-containing surfactant was not used. Thus, in these examples, the nonionic non-fluorine-containing surfactant was excluded, as now set forth in applicant's claims. Claims 1 and 6 remain in the application for consideration by the Examiner.

Claim 1 was rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for a particle size of less than 200 nm, does not reasonably provide enablement for 320.1 nm. The Official Action continued that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The Official Action stated that applicant's invention is directed to VdF polymer having a particle size of less than 200 nm, noting page 1, lines 8-15, of applicant's specification disclosure.

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Official Action stated evidence that Claim 1 fails to correspond is scope with that which applicant regards as the invention can be found in the Abstract, page 1, lines 8-15, and page 4, lines 6-12, in the specification which clearly state that the invention is directed to a polymer having a particle size of not more than 200 nm.

Claim 6 was rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Official Action stated that page 3, lines 6-10, of applicant's specification states: "when the fluorine-containing surfactant is used solely and its amount is not more than 1% by weight, there cannot be obtained a particle size of not more than 200 nm if the solid content is assumed to be 30 to 50 % by weight." The Official Action also noted page 6, lines 25-27, of applicant's specification disclosure.

Applicant respectfully submits that these rejections under 35 U.S.C. § 112 are misplaced and should be reconsidered and withdrawn. For example, the rejection under 35 U.S.C. § 112, second paragraph, attempts to state that the Claim 1 is indefinite because it has a scope different than that set forth in the specification. This type of reasoning is improper. As stated in *In re Borkowski*, 442 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970) (footnotes omitted, emphasis in original):

> The first sentence of the second paragraph of §112 is essentially a requirement for precision and definiteness of claim language. If the scope of subject matter embraced by a claim is clear, and if the applicant has not otherwise indicated that he intends the claim to be of a different scope, then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention. That is to say, if the "enabling" disclosure of a specification is not commensurate in scope with the subject matter encompassed by a claim, that fact does not render the claim imprecise or indefinite or otherwise not in compliance with the

> second paragraph of §112; rather, the claim is based on an insufficient disclosure (§112, first paragraph) and should be rejected on that ground.

Borkowski has been cited for this holding in the more recent cases of *In re Hyatt*, 218 USPQ 195 (CA FC 1983), and *Personalized Media Communications LLC v. ITC*, 48 USPQ2d 1880 (CA FC 1998). Accordingly, applicant respectfully submits that the rejection under the second paragraph of 35 U.S.C. § 112 based on a non-enabling disclosure is improper and should be reconsidered and withdrawn.

Applicant further respectfully submits that the present specification both enables and provides an appropriate written description of the invention as set forth in Claims 1 and 6 within the meaning of the first paragraph of 35 U.S.C. § 112.

The courts have long and clearly recognized that 35 U.S.C. § 112, first paragraph, includes a description of the invention requirement and an enablement requirement. *In re Bowen*, 181 USPQ 48 (CCPA 1974); *In re Smith*, 178 USPQ 620 (CCPA 1973); *In re Moore*, 169 USPQ 236 (CCPA 1971). Thus, the first paragraph of 35 U.S.C. § 112 contains separate requirements for --

> a description [1] of the invention, and [2] of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . . .

In order to comply with 35 U.S.C. §112, first paragraph, all that is required is that the application reasonably conveys to persons skilled in the art

that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him. *In re Lukach*, 169 USPQ 795 (CCPA 1971); *In re Edwards*, 196 USPQ 465 (CCPA 1975). The basic premise is that the test for determining whether the disclosure complies with the description of the invention requirement is whether it would have reasonably conveyed to one of ordinary skill in the art that the inventor invented the later-claimed subject matter. *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The invention claimed does not have to be described *ipsis verbis* (in the identical words) in order to satisfy the description requirement the first paragraph of Section 112. *Martin v. Johnson*, 172 USPQ 391, 395 (CCPA 1972); *Case v. CPC International, Inc.*, 221 USPQ 196, 201 (Fed. Cir.), *cert. denied*, 224 USPQ 736 (1984).

Firstly, considering the description requirement, the present specification contains Comparative Example 4. The dispersion prepared in this comparative example does not contain a nonionic non-fluorine-containing surfactant and contains particles with a size of 320.1 nm. Thus, this comparative example establishes that at the time the application was filed, the applicant had in his possession a dispersion such as that set forth in the present claims. Further, this comparative example also enables one of ordinary skill in the art to make the invention as set forth in the claims, because what is in the claims is the same as what is in the comparative example.

In addition, applicant's specification at page 3, line 34, through page 4,

line 4, and page 4, line 7-12, describes a dispersion using only a fluorine-containing surfactant in the amount of not more than 1% by weight on the basis of water, thereby also providing a written description of the invention that corresponds to Claim 6. Table 1 on page 13 of applicant's specification, when describing referring to Comparative Example 4 identifies a particle size of 320.1 nm, thus providing a written description of this aspect of the presently claimed invention.

It is respectfully noted that the Official Action attempted to support the rejections under 35 U.S.C. § 112, first paragraph, by referring to other portions of applicant's specification disclosure as allegedly conflicting with the invention set forth in Claims 1 and 6. Firstly, applicant respectfully submits that the portions of applicant's specification disclosure cited by the Examiner simply discuss another embodiment of the presently claimed invention. Also, applicant respectfully submits that referenced by the Examiner to other portions of the present specification in order to define what he believes is the applicant's invention is improper. As explained in *Borkowski*, 35 U.S.C. § 112 does not permit the Examiner to study applicant's disclosure, formulate a conclusion as to what the Examiner regards as the invention supported by the disclosure, and then determine whether the claims are proper based on the Examiner's conception of what the invention is.

Furthermore, the fact that the applicant may have realized the

significance of the presently claimed invention after the application was filed does not negate its patentability. The last sentence of paragraph (a) of 35 U.S.C. § 103 states that "Patentability shall not be negatived by the manner in which the invention was made." This sentence of 35 U.S.C. § 103 means that it immaterial from the viewpoint of patentability how the invention was arrived at, whether it be from long toil and experimentation or from a flash of genius. *Mathis v. Spears*, 8 USPQ2d 1029 (CA FC 1988). Accordingly, applicant respectfully submits that the fact that the invention was possibly realized as set forth in the present claims after the application was filed should be not be held against the patentability of the presently claimed invention.

For the foregoing reasons, applicant respectfully submits that the presently claimed invention is supported in the present specification disclosure within the meaning of 35 U.S.C. § 112, first paragraph. Therefore, applicant respectfully request that the Examiner reconsider and withdraw this rejection.

Claims 1 and 6 were rejected under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,708,463 of Stallings or U.S. Patent No. 4,025,709 of Blaise *et al.* (Blaise). The Office Action stated that Stallings discloses a process for preparing vinylidene fluoride homopolymer (Claim 1) using 0.1% to 1.5% fluorinated surfactant (Claim 5), preferably 0.5 - 1.0% (column 4, lines 15-17), based on the monomer. The Office Action continued that in Example 1 the fluorinated surfactant concentration is 0.27%

and the solids concentration is 26.3%. With respect to Blaise, the Office Action stated that Blaise teaches 0.12 % fluorinated emulsifier and a latex containing 35% solids.

Applicant respectfully submits that the teachings of Stallings or Blaise do not disclose or suggest the invention as set forth in the present claims within the meaning of 35 U.S.C. § 102 or 35 U.S.C. § 103.

The teachings of Stallings and Blaise are concerned with compositions that contain a nonionic non-fluorine-containing surfactant. At column 3, lines 16-20, Stallings describes that the non-ionic non-fluorine-containing surfactant (lower alkylene oxide) is required in the dispersion system proposed therein. Similarly, in the teachings of Blaise the invention revolves around the surprising discovery of the beneficial use of good surfactants such as sodium lauryl sulfate or the nonylphenoloxyethylene types. In contrast to the teachings of Stallings and Blaise, the presently claimed invention excludes a nonionic non-fluorine-containing surfactant. Since the teachings of Stallings and Blaise require a nonionic non-fluorine-containing surfactant, applicant respectfully submits that such teachings could not possibly motivate one of ordinary skill in the art to a dispersion not containing a nonionic non-fluorine-containing surfactant, as required by the present claims.

As acknowledged in the Office Action, there is no discussion in the teachings of Stallings concerning the amount of solids proposed therein. The

Office Action calculated the solids content in Stallings to be 26.3%. The Office Action then stated that 26.3% is close enough to 30% to make it obvious, especially when high solid concentrations are desirable. Applicant cannot agree with this position. Applicant respectfully submits that the amount of 26.3% cannot render the presently claimed amount of 30% obvious with the meaning of 35 U.S.C. § 103. Firstly, there is a significant difference between 26.3% and 30%. Secondly, the teachings of Stallings do not explain that high solid concentrations are desirable. Thus, one skilled in the art would not be motivated to higher solid contents as presently claimed based on the teachings of Stallings.

Furthermore, Example 1 of Stallings discusses an average particle size of 0.5 microns, which is equivalent to 500 nm. This size is less that the average particle sizes set forth in Claims 1 and 6. Accordingly, applicant respectfully submits that the teachings of Stallings cannot contemplate or suggest the invention set forth in the present claims.

The teachings of Blaise proposed a latex having a concentration of polymer equal to 35% by weight. The main deficiency in the teachings of Blaise is that there is no discussion concerning particle size. Applicant respectfully submits that it is understood by those skilled in this art that the particle size of the emulsion-polymerized PVdF polymer becomes smaller within the increase of amount of surfactant and with a decrease in polymer (solids) contents.

Since the teachings of Blaise propose a large solids content, the particle size of the emulsion must be large. This appears to be confirmed by the fact that the polymer in Blaise cannot be molded except by compression and/or the fact that the molecular weight of the polymer is high. Accordingly, applicant respectfully submits that the teachings of Blaise cannot contemplate or suggest the invention set forth in the present claims.

For the foregoing reasons, applicant respectfully submits that the presently claimed invention is distinguishable from the teachings of Stallings and Blaise. Therefore, applicant respectfully requests the Examiner reconsider and withdraw this rejection.

While it is believed that the present response places the application in condition for allowance, should the Examiner have any comments or questions, it is respectfully requested that the undersigned be telephoned at the below listed number to resolve any outstanding issues.

In the event this paper is not timely filed, applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which may become due, may be charged to our Deposit Account No. 22-0256.

Respectfully submitted,
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